
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: THOMAS
Application No.: 10/039,341
Filed: December 31, 2001
Title: SYSTEM AND METHOD FOR
MONITORING DOMAIN NAME
REGISTRATIONS

Attorney Docket No.: CDTP006D1
Examiner: AL HASHEMI, SANA A.
Group: 2164

PRE-APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants appeal the rejection of claims in the final Office Action dated May 16, 2008. Applicants request careful consideration of this Pre-Appeal Brief in advance of Applicant's submission of a formal appeal brief.

A. Introduction

Claims 1-27 and 31-36 remain pending. In the final Office Action, the Examiner rejected claims 1-12 and 31-37 under 35 U.S.C. § 103. This rejection should be withdrawn for at least the reasons noted below.

B. No Prima Facie Rejection

From the Office Action, claim 13 was not be clearly rejected and claims 14-27 were not at all rejected. While claim 13 is mentioned at page 2 of the final Office Action in conjunction with a discussion of claim 1, the particular basis for the rejection of this claim is unclear. Further, there is no basis in the final Office Action for the rejection of claims 14-27 as these claims are nowhere mentioned. Accordingly, it is submitted that the final Office Action fails to set forth a *prima facie* rejection as to claims 13-27.

C. Rejection of Claims 1-12 and 31-37 under 35 USC 103

Claims 1-10 and 32-37 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Schneider (USP 6,338,082) in view of Balijepalli (US Pub. 2004/0230566). This rejection is respectfully traversed.

The Office Action contends that the elements of the presently claimed invention are disclosed in Schneider except that “Schneider differs in that the search step is not recited as being performed periodically and automatically”. The Office Action further contends that “Balijepalli teaches the concept of periodically and automatically performing a search for data on a network (paragraph 0008, last two lines) in order to return the most relevant and recent information to the user (paragraph 0004, last three lines)” and that it would be obvious to one having ordinary skill in the art at the time of the invention to “modify Schneider to perform periodic automatic searches and automatically deliver the results to the user in order to provide the most relevant and current information, as taught by Balijepalli.” The Applicants respectfully disagree for the reasons, among others, set forth below.

1. Monitoring Domain Name Registrations – Not taught or Suggested

Claim 1 operates to receive a request to monitor a name with respect to domain name registrations. The request of claim 1 is not an immediate search of a domain name database but is instead a request to monitor for new domain name registrations over time. The Office Action is thus incorrect in stating that “initiating a search” as disclosed in Schneider is an act of monitoring. Consequently, Schneider fails to teach or suggest monitoring domain name registrations as recited in claim 1. The final Office Action also does not allege that Balijepalli is able to teach or suggest monitoring domain name registrations as recited in claim 1.

2. Domain Space – Not taught or Suggested

Claim 1, among other things recites “determining a domain space about the name to be monitored, the domain space including at least one domain variation of the name to be monitored”. As to this limitation, the Office Action relies on col. 5, lines 5-16 of Schneider. However, such portion of Schneider merely discusses domain name availability with a NIC authority. Schneider offers no teaching or suggestion of a

domain space having at least one domain variation of a name to be monitored. The final Office Action also does not allege that Balijepalli is able to teach or suggest monitoring a domain space as recited in claim 1.

3. No Motivation to Combine the References

The rejection of claim 1 is premised on the combination of Schneider and Balijepalli. Balijepalli describes a web-based customized information retrieval and delivery method. Initially, Applicant submits that there is no reasonable expectation of success that the alleged combination of Schneider and Balijepalli would result in the claimed invention. One of ordinary skill in the art would not believe it reasonable to combine Schneider with Balijepalli as proposed by the Office Action. Schneider concerns redirecting a user to a registration service for domain names if a domain name of a network resource request is unresolvable or cannot be located [instead of displaying an error message]. Balijepalli is searching for “information corresponding to items contains in a user search list from two or more information sources on the World Wide Wed (WWW)” (see abstract). Claim 1 pertains to monitoring a domain space in a periodic and automatic manner. It, however, is not reasonable to assume that one skilled in the art would be motivated to operate Schneider in a periodic and automatic manner. Schneider redirect a user following a specific user request for a network resource. If would not be logical for the user of Schneider to automatically and periodically initiate the same network resource request as the result would be the same – redirection to a registration service. Accordingly, it is submitted it is not reasonable to conclude that one of ordinary skill in the art would combine Schneider with Balijepalli as proposed by the final Office Action.

4. Periodic and Automatic Monitoring – Not taught or Suggested

On page 3 of the final Office Action, the Examiner admits that Schneider fails to teach periodic and automatic monitoring for domain name registrations as recited in claim 1. However, the Examiner relies on Balijepalli to overcome this deficiency of Schneider.

Balijepalli describes a web-based customized information retrieval and delivery method. Balijepalli is searching for “information corresponding to items contains in a

user search list from two or more information sources on the World Wide Web (WWW)” (see abstract). Although the searching in Balijepalli can be periodic, the searching nevertheless remains as a search for information from two or more information sources on the World Wide Web (WWW). In contrast, claim 1 is instead monitoring for domain name registrations on a periodic and automated manner. Balijepalli, like Schneider, fails to teach or suggest any ability or need to monitor for domain name registration on a periodic and automated manner.

Based on the foregoing, it is submitted that claim 1 is patentably distinct from Schneider and Balijepalli. In addition, it is submitted that claims 2-10 and 34-37 are also patentably distinct for at least the same reasons as their corresponding independent claim. The additional limitations recited in the independent claims or the dependent claims are not further discussed as the above-discussed limitations are clearly sufficient to distinguish the claimed invention from Schneider. However, as an example, claims 34 and 37 recite sending a warning message to a registrant, which as noted below is not taught or suggested by Schneider or Balijepalli.

Thus, it is respectfully requested that the rejection of claims 1-10 and 34-37 under 35 USC § 103(a) be withdrawn.

D. Rejection of Claims 11-12, 31 and 33 under 35 USC 102(e)

Claims 11, 12, 31, and 33 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Schneider. This rejection is respectfully traversed. Claim 11 is an independent claim.

Specifically, the final Office Action states that the “displayed search results from the WHOIS database search (step 318) would constitute a warning message indicating that a domain name is in use by another party.” Applicant respectfully disagrees for the reason, among others, discussed below.

Claim 11 provides for “sending warning messages to registrants of the identified one or more registrations.” (emphasis added). Here, it is the offending registrant that is being sent a warning message. That is, the warning message is sent to the registrant of a domain name identified by searching a database of domain name registrations.

Schneider, at best, teaches merely notifying a requestor that a domain name is not available. Indeed, page 5 of the Office Action (discussing Schneider) states “Step (318) illustrates the return to the requestor of a displayed record of a domain name which such domain name is identified in the WHOIS database system. The displayed search results from the WHOIS database search (step 318) would constitute a warning message indicating that a domain name is in use by another party.” First, the displayed search results from the WHOIS database is in no way a warning message. It is instead mere registration information. Second, the alleged “warning message” in Schneider is necessarily provided to the requestor of its search. In contrast, claim 11 is sending warning messages to registrants associated with the one or more registrations of domain names that have been identified, and not to the requestor who is monitoring availability of a name. Accordingly, Schneider fails to teach or suggest “sending warning messages to registrants of the identified one or more registrations” as claimed in Claim 11. Also, as noted above with respect to claim 1, Schneider also does not teach or suggest monitoring domain name registrations.

Based on the foregoing, it is submitted that claim 11 is patentably distinct from Schneider. In addition, it is submitted that claims 12, 31, and 33 are also patentably distinct for at least the same reasons as their corresponding independent claim. The additional limitations recited in the independent claims or the dependent claims are not further discussed as the above-discussed limitations are clearly sufficient to distinguish the claimed invention from Schneider.

Thus, it is respectfully requested that the rejection of the claims 11, 12, 31, and 33 under 35 USC § 102(e) be withdrawn.

Respectfully submitted,
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